

Remarks

Claim Status:

Claims 40, 41 and 52-63 are pending. Claim 40 is amended without prejudice.

Formal Rejections:

Claims 40, 41 and 52-55 are rejected as failing to comply with the written description requirement. We respectfully traverse these rejections.

In particular, it appears that the term “active” is questioned. The Office Action suggests that a definition is not provided for the term. We disagree.

For example, the Specification provides a definition as follows on pages 11, lines 25-29.

Wherever the database is located, the database can have only entries for songs included in the play list, or songs in the play list are highlighted as active. The latter means only the active entries are changed when the play list is updated, whereas the former means the database entries for newly added songs have to be added and database entries for songs in the database not included in the new play list have to be deleted.

Thus, in the context of claim 40, the term “active” means, e.g., an indication or other designation showing which entries are to be changes when a playlist is to be updated. The term “highlighted” is added to claim 40 without prejudice to even better conform to the above cited passage.

Withdrawal of these rejections is requested.

Drawings & Specification Objections:

The drawings and specification are objected to variously for needing to show each features of the claims, and for introducing new subject matter.

We traverse these rejections and ask for reconsideration in view of the above comments (under “Formal Rejections”).

We also note that claim 40 has been amended; and ask for consideration of the new claim language in view of these objections.

Reconsideration is requested.

Claim 40 is amended without conceding the merits of the Office Action's "antecedent basis" rejection. See the Office Action, page 5. We respectfully request reconsideration.

Art-Based Rejections:

Claims 40, 41 and 52-63 stand rejected as being anticipated by US Published Application No. US 2003-0027010 A1 (hereafter referred to as "Schmelzer").

We traverse these rejections.

Claim 40 in view of Schmelzer

It is well settled that in order for an Office Action to establish a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. See generally, *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78 (Fed. Cir. 1988); and *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

The Office Action fails to establish a *prima facie* case of anticipation since the cited Schmelzer paragraph (34) does not have at least *identifying a subset* of the list of content items, the subset including content items highlighted as active content items, the subset comprising content items subject to updates; and *interrogating the subset of the list of content items* with the at least one fingerprint to identify the monitored or obtained content item

While the cited Schmelzer passage discusses comparing a generated fingerprint with an archive of fingerprints, we do not see mention of an act of identifying a subset from the list of content items, the subset including content items highlighted as active content items; and then interrogating the subset as recited in claim 40.

Reconsideration is respectfully requested.

Remaining Claims

Reconsideration of the remaining claims is respectfully requested too.

Conclusion:

We look forward to our upcoming interview (see page 5, above). In the meantime, the Examiner is invited to contact the undersigned with any questions.

Date: November 17, 2010

Customer No. 23735

Phone: 503-469-4685

FAX: 503-469-4777

Respectfully submitted,

DIGIMARC CORPORATION

By: /Steven W. Stewart, Reg. No. 45,133/
Steven W. Stewart
Registration No. 45,133